

**REMARKS**

Claims 1-16 are pending in the present application. Claim 1 and 16 are independent.

**Drawing Objection**

Figs. 22 and 23 are objected to because they should be designated by a legend indicating their conventional art status. This objection is respectfully traversed.

A proposed drawing correction has been submitted concurrently herewith which adds the appropriate label "Prior Art" to both Figs. 22 and 23. In view of this proposed drawing correction, Applicant respectfully seeks approval thereof and reconsideration and withdrawal of the corresponding drawing objection.

**Allowable Subject Matter**

Applicant appreciates the Examiner's indication that claims 4, 5 and 8-15 recite allowable subject matter and would be allowed if rewritten in independent form including all of the features of the base claim and any intervening claims. For the reasons discussed below, it is believed that all of the pending claims are in condition for allowance and Applicant earnestly solicits an early indication of allowability therefore.

**Art Rejection**

Claims 1-3, 6, and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kato (USP 6,504,826). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Although Kato is indeed directed to a digital broadcasting receiver this invention is directed to an entirely different problem and includes entirely different features than those recited in the pending claims.

Specifically, Kato is directly directed to the problem which occurs when the image bit stream changes resolution. For example, when the image data resolution changes from a standard resolution to a high resolution the difference in the number of picture elements per frame can cause an unpleasant viewing experience. This is discussed in column 2, lines 55-60.

To solve this problem, Kato detects identification information of the image or audio from the received digital information. A change in this identification information indicates a change in resolution. Kato detects this change in identification information and utilizes this change to stop the display or output of the image and/or sound data. This is discussed in column 3, lines 10-28.

As discussed therein, such a change in resolution causes the image or audio to be "disordered." To prevent this disordered information from being viewed or heard by a user, Kato stops the

output of such disordered information in the form of display or sound. Kato further accomplishes this goal by sending a command from the analyzing control unit 24 (that detects a change in ID information) to the decoding unit 25 (see column 4, lines 22-52 and also column 5, lines 30-67).

These features and general inventive purpose simply do not disclose or suggest the claimed invention.

Specifically, Kato does not disclose or suggest the claimed parameter set means for setting the program parameter described in the information table included in the digital broadcast signal as a signal extraction parameter as recited in claim 1. Indeed, the Office Action explicitly agrees with this argument by admitting that Kato does not expressly disclose the claimed parameter set means (see page 3, first paragraph of the Office Action).

In order to supply a teaching as to this parameter set means, the Office Action cites Applicant's own specification (see page 3, first paragraph of the Office Action).

It is axiomatic that Applicant's own specification cannot be used to supply evidence of conventional or prior art status of a claim element. But this is exactly what the Office Action does by pointing to Applicant's own specification to supply a teaching as to the parameter set means. This is classic hindsight reconstruction of the invention which is not permitted according to black letter patent law. Hence, to the limited extent that the

cited reference might be modified so as to accomplish Applicant's claimed invention (a fact that Applicant strongly contends, *supra*, cannot be done), it is only through the "blueprint drawn by the inventor," *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985), that that combination can be assembled, not from the state of the art at the time of Applicant's invention as it must be.

The Office Action then concludes that "in light of the foregoing disclosure, it would have been obvious for one of ordinary skill in the art at the time the invention was made that the analyzing control unit 14 as taught by Kato et al performs the same function of the controller 13 as claimed in the patent application."

Indeed, the "foregoing disclosure" includes Applicant's own specification. Only by using hindsight reconstruction and Applicant's own specification can the Office Action conclude that it would have been obvious to provide a parameter set means as claimed. Such an argument is clearly not permitted by standard U.S. patent law. If the Office Action intends to maintain the rejection of any claim, it is respectfully requested that a proper reference be supplied that is outside the patent application specification now being examined. Without such evidence, the claims must be allowed.

Further arguments set forth in the Office Action are directed to the signal extraction means and also must fail because they rely upon improper evidence of prior invention, namely the patent application specification itself. This is not a proper source of prior art evidence as argued above.

The Office Action further admits that Kato does not expressly disclose that the analyzing control unit 14 of Kato detects a content change in the information table as claimed. Nevertheless, it is concluded that when a viewer selects a program channel the control information corresponding to the selected channel is set. The Office Action further concludes based on this statement that it would have been obvious that the viewer selection of a channel corresponds to a predetermined criterion as claimed.

This obviousness statement misses the point of claim 1 which recites a parameter set means that detects content change of the information table on the basis of a predetermined criterion. The Office Action clearly admits that no such content change is disclosed by Kato. Without such a teaching it is not understood how Kato could possibly be modified to include such a parameter set means as claimed.

Even if it could be modified as the Office Action suggests, the parameter set means not only detects content change of the information table but also sets the program parameter (that is described in the information table) as a signal extraction

parameter upon detecting the content change. This signal extraction parameter is utilized by the signal extraction means to extract a program signal from a digital broadcast signal.

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However, Kato does not even detect content change or a parameter set means that sets the program parameter as a signal extraction parameter as clearly admitted by the Office Action. There are several significant features of the invention clearly not taught by Kato. The Office Action even admits this but nevertheless concludes that it would have been obvious to modify Kato to arrive at the claimed invention. These statements are entirely lacking of proper evidence. The Office Action leans heavily upon hindsight reconstruction to conclude obviousness and has supplied no proper teaching as to several claimed elements of the invention. Therefore, the rejection must fail.

Although the Office Action makes several misstatements as to the dependent claims, Applicant wishes to focus the patentability of his invention upon the independent claim 1.

It is emphasized that the amendments to claim 1 are not to distinguish the invention from the applied art. Instead, the amendments clarify the operation of the parameter set means such that it is more readily understood by the Examiner and the public at large when a patent is granted on this invention.

For all of the above reasons, taken alone or in combination, Applicant respectfully requests reconsideration and withdrawal of the art rejection.

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**Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael R. Cammarata (Reg. No. 39,491) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

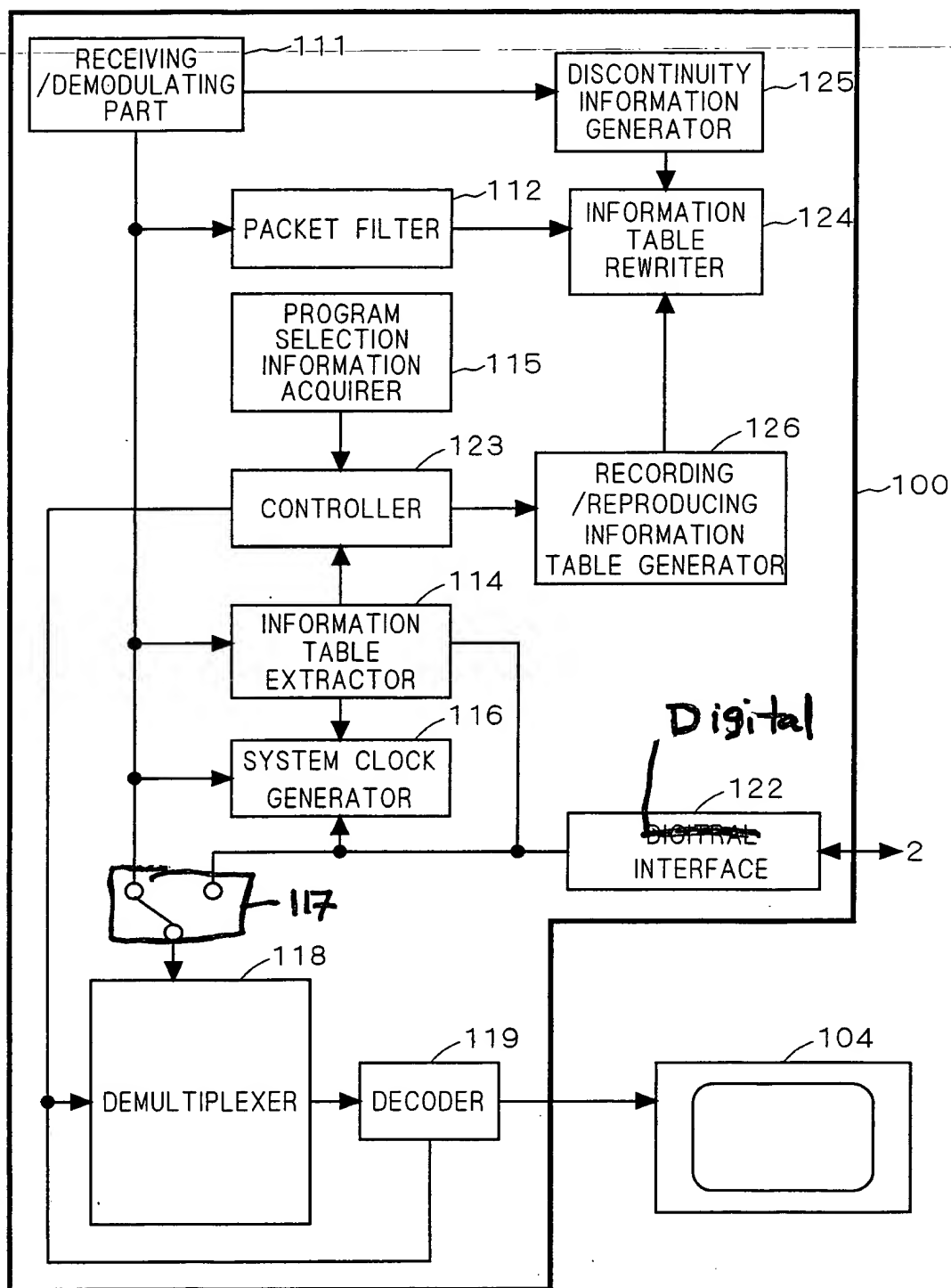
By   
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FIG. 22

*Prior Art*







*Prior Art*

FIG. 23

